



DAC/1745  
#

PATENT  
0171-07635  
**RECEIVED**  
JAN 15 2004  
TC 1700

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: SAITO, Kazuo et al. Conf.: 2711  
Appl. No.: 09/899,107 Group: 1745  
Filed: July 6, 2001 Examiner: Alejandro, R.  
For: FUEL CELL SEPARATOR, PROCESS FOR PRODUCTION  
THEREOF, AND POLYMER ELECTROLYTE FUEL CELL

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**OFFICE OF PETITIONS**

PETITION TO THE COMMISSIONER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

December 4, 2003

Sir:

NOW COMES the undersigned and petitions the Commissioner pursuant to the statute and the rules and particularly 37 CFR 1.181, 1.182, and 1.183 and respectfully requests the Commissioner to grant the indicated relief.

Relief Requested

The Commissioner is requested to allow this application.

In the alternative, the Commissioner is requested to close prosecution on the merits under the practice provided for in Ex parte Quayle and MPEP 706.07(f).

In the further alternative the Commissioner is requested to withdraw the finality of the final rejection, as improvidently issued, and issue a new non-final office action identifying those grounds of rejection not yet overcome.

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The Commissioner is further requested to grant such other relief as seems just under the circumstances including the refund of all extension fees, all notice of appeal fees, all brief filing fees and every other fee of any kind, paid in the past or in the future, because of the apparent loss of the certified translation of a certain priority document timely filed in the PTO but apparently never matched with the official PTO file in this case.

#### Facts

On February 20, 2003 a non-final office action issued in this case. That office action relied on certain documents that would not be prior art if a certified translation of the priority document were filed.

On May 16, 2003 a document entitled "Reply Under 37 C.F.R. §1.111" together with a certified translation of the priority document were filed. These documents were filed in the U.S. Patent and Trademark Office's mailroom as discussed below.

On June 5, 2003 a final rejection was issued stating in part "the priority document has not been found or made of record". (Office Action mailed June 5, 2003; page 4; line 9). Approximately three (3) weeks later, on or about June 25, 2003 a document entitled "Reply After Final Rejection Under 37 C.F.R. §1.116", copy attached as Exhibit A<sup>1</sup>, was filed. Attached to

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<sup>1</sup> Exhibit A and every other exhibit referred to herein are part

Exhibit A was a postcard receipt, copy attached as Exhibit B, showing the earlier filing on May 16, 2003 of the "English Translation of Priority Document, Japanese No. 2000-204728". On June 26, 2003 an additional copy of this same certified translation was filed as shown by the listing as attached on page 3 of Exhibit A.

Exhibits A, B, and the certified translation were filed by sending them by facsimile with a cover sheet attached as Exhibit D. The cover sheet shows that Exhibits A, B, C, and D were sent to fax number 703-872-9311, the same fax number specified for after final communications and given on page 5, line 9 of the final rejection mailed June 5, 2003.

A transaction report, copy attached as Exhibit E indicates that 37 of the 38 pages were sent.

The U.S. Patent and Trademark Office received these 37 pages as shown by a document entitled "Auto-Reply Facsimile Transmission" a copy of which is attached hereto as Exhibit F.

The missing page was transmitted within a few days.

#### Argument

It is clear from the above facts that the PTO timely received the certified translation on a date prior to the date of issuance

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of a document entitled "Letter" timely filed in this case on or about October 17, 2003. A copy of this letter and all its exhibits is attached hereto as "Attachment(1) "

of the final rejection. If the Examiner would have had the certified translation before him he would not have issued the final rejection. The certified translation was later submitted a second time but has not yet found its way into the file. It is the duty of the Commissioner to see that all properly filed documents are placed in the file so that the Examiner can consider them in acting on a case. That did not happen in this case. It is manifestly unfair to burden the applicant with both attorney fees and government fees paid for the sole purpose of preventing abandonment because the PTO can not find the certified translation of the priority document notwithstanding multiple submissions thereof.

The Commissioner should either allow this case or issue a non-final office action indication any remaining grounds of rejection. In any case all fees paid, solely to prevent abandonment because of the misplacement by the PTO of the certified translation, should be refunded.

#### Concurrent Actions

Concurrently with the filing of this petition the undersigned is filing a Notice of Appeal and extension request covering the three-month period since the improvidently issued final rejection. This is being done for the sole purpose of giving the PTO sufficient time to find the lost certified translation and take

appropriate action. A refund of all these fees is respectfully requested.

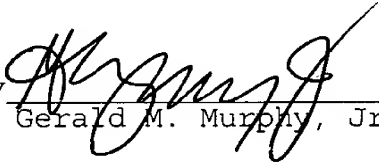
Fees

The fee for this petition is attached hereto. A refund of this fee is requested for the reasons above stated.

Should the Commissioner determine that any additional fee is required by virtue of the filing of this document he is respectfully authorized in this, concurrent, and future replies, to charge payment or credit any refund and any overpayment to Deposit Account No. 02-2448 for any additional fees required.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Gerald M. Murphy, Jr., #28,977

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

GMM/DRM/drm  
0171-0763P

Attachments:

(1) Document entitled "LETTER" with all its exhibits, originally filed on or about 17 October 2003 reproduced herewith at about 80% of original size to avoid confusion with the original "LETTER" if it is later found at the PTO

(2) A petition fee in the form of Check No. 9010211 for \$130.00 in accordance with fee code 1460, pursuant to 37 CFR 1.17(h)

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OFFICE OF PETITIONS



PATENT  
0171-0763P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: SAITO, Kazuo et al. Conf.: 2711  
Appl. No.: 09/899,107 Group: 1745  
Filed: July 6, 2001 Examiner: Alejandro, R.  
For: FUEL CELL SEPARATOR, PROCESS FOR PRODUCTION  
THEREOF, AND POLYMER ELECTROLYTE FUEL CELL

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JAN 15 2004  
TC 1700

LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

October 17, 2003

Sir:

The Commissioner is respectfully requested to either allow this application or indicate which statutory requirements have not yet been made.

FACTS

On February 20, 2003 a non-final office action issued in this case. That office action relied on certain documents that would not be prior art if a certified translation of the priority document were filed.

On May 16, 2003 a document entitled "Reply Under 37 C.F.R. §1.111" together with a certified translation of the priority document were filed. These documents were filed in the U.S. Patent and Trademark Office's mailroom as discussed below.

On June 5, 2003 a final rejection was issued stating in part "the priority document has not been found or made of record".

ATTACHMENT (1) TO  
PETITION TO COMMISSIONER

*OK*  
12-1-03

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OFFICE OF PETITIONS

(Office Action mailed June 5, 2003; page 4; line 9). Approximately three (3) weeks later, on or about June 25, 2003 a document entitled "Reply After Final Rejection Under 37 C.F.R. §1.116", copy attached as Exhibit A, was filed. Attached to Exhibit A was a postcard receipt, copy attached as Exhibit B, showing the earlier filing on May 16, 2003 of the "English Translation of Priority Document, Japanese No. 2000-204728". On June 26, 2003 an additional copy of this same certified translation was filed as shown by the listing as attached on page 3 of Exhibit A.

Exhibits A, B, and the certified translation were filed by sending them by facsimile with a cover sheet attached as Exhibit D. The cover sheet shows that Exhibits A, B, C, and D were sent to fax number 703-872-9311, the same fax number specified for after final communications and given on page 5, line 9 of the final rejection mailed June 5, 2003.

A transaction report, copy attached as Exhibit E indicates that 37 of the 38 pages were sent.

The U.S. Patent and Trademark Office received these 37 pages as shown by a document entitled "Auto-Reply Facsimile Transmission" a copy of which is attached hereto as Exhibit F.

The missing page was transmitted within a few days.

REMARKS

The courtesies extended to David R. Murphy by Examiner Alejandro are acknowledged with appreciation. The following comments incorporate the substance of a recent conversation between David R. Murphy and Examiner Alejandro. Examiner Alejandro informed this office that the U.S. Patent and Trademark Office information retrieval system (PAIR) indicated that the above documents have not yet been entered by the U.S. Patent and Trademark Office. The Examiner attempted to locate the paper file but informed this office that the paper file was located in Customer Service.

The Commission is respectfully requested to transfer the file from the Customer Service division to the office of Examiner Alejandro so that the Examiner can act on this case.

FEES


It is respectfully submitted that no fee is required by virtue of this submission. Although the final rejection mailed June 5, 2003 set a three-month shortened statutory period expiring on September 5, 2003; and even though that date is passed no action of substance is being requested by the attorneys of record in this case. This Letter only requests that earlier timely filed documents be acted upon.




However should the Commissioner determined that any fee is required by virtue of the filing of this letter he is respectfully authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Gerald M. Murphy, Jr., #28,977

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

  
GMM/DRM/jeb  
0171-0763P

(Rev. 09/30/03)

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MS AF  
REPLY UNDER  
37 C.F.R. § 1.116  
EXPEDITED PROCEDURE

PATENT  
0171-0763P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: SAITO, Kazuo et al. Conf.: 2711  
Appl. No.: 09/899,107 Group: 1745  
Filed: July 6, 2001 Examiner: Alejandro, R.  
For: FUEL CELL SEPARATOR, PROCESS FOR  
PRODUCTION THEREOF, AND POLYMER  
ELECTROLYTE FUEL CELL

REPLY AFTER FINAL UNDER 37 C.F.R. § 1.116

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TC 1700

MS AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 25, 2003

Sir:

In reply to the Final Office Action dated June 5, 2003, the following remarks are respectfully submitted in connection with the above-identified application.

REMARKS

A certified English translation of the priority document, namely Japanese Patent Application No. 2000-204728 was timely filed in this application on May 16, 2003 as shown on the



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OFFICE OF PETITIONS

attached postcard receipt.

The U.S. Patent and Trademark Office has the necessary certified translation. A copy of the certified copy is submitted herewith via Facsimile as suggested in paragraph 3, page 4 of the last Office Action.

It is respectfully submitted that this submission overcomes any rejection under 35 U.S.C.102. It is further respectfully submitted that all pending claims are allowable and that the application is in condition for allowance.

The Examiner is respectfully requested to pass the case to issue.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below.



If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

COPY

By \_\_\_\_\_  
Gerald M. Murphy, Jr., #28,977

GMM/DRM: bmp  
0171-0763P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachments: Copy of certified translation of Japanese  
Patent Application No. 2000-204728  
Copy of postcard receipt

Certificate of Transmission  
I hereby Certify that this correspondence is being  
transmitted to the Patent and  
Trademark Office:  
on June 26, 2003  
Date  
Signature Barbara M. Pate  
Barbara M. Pate  
Printed name of person signing certificate

(Rev. 04/30/03)



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JAN 15 2004  
TC 1700

Papers Filed herewith on: May 16, 2003  
DOCKET NO.: 017-0763P ATTY: 6444/DRH  
APPLICANT(S): Saito et al.  
APPLN. NO.: 09/299,107 FILED: 07-06-2001  
PAT. NO.: \_\_\_\_\_

☐ New Application with Transmittal Letter  
☐ Utility ☐ Design ☐ CIP ☐ PCT ☐ Provisional  
☐ Filing Under 37 CFR 1.53(b) ☐ CONT ☐ DIV  
☐ Filing Under 37 CFR 1.53(d) (CPA)  
☐ Filing Under 37 CFR 1.114(RCE)  
☐ Specification Consisting of: \_\_\_\_\_  
☐ Combined Declaration & Power of Attorney  
☐ Assignment / Cover Letter  
☐ Letter to Official Draftsman  
☐ Drawings \_\_\_\_\_ Sheets ☐ Formal ☐ Informal ☐ Red-Ink  
☐ Completion of Filing Requirements, PCT/DOC 905  
or Formalities Letter and Executed Declaration  
☐ Priority Document(s) / Cover Letter, No. Doc. \_\_\_\_\_  
☒ Amendment: under 37 CFR 1.111  
☒ Transmittal Ltr ☐ Large Entity ☐ Small Entity  
☐ Response  
☐ Information Disc Stmt. PTO-1449(s) \_\_\_\_\_ doc(s)  
☐ Notice of Appeal ☐ Appeal Brief  
☐ Issue Fee Transmittal  
☐ FEES: \_\_\_\_\_  
☐ Letter: \_\_\_\_\_  
☒ Other: ENGLISH TRANSLATION OF  
PRIORITY DOCUMENT  
JAPANESE 2000-204728

Receipt is hereby acknowledged of the papers filed as  
indicated in connection with the above identified case.  
COMMISSIONER OF PATENTS AND TRADEMARKS  
Due Date: 05-20-2003  
Handcarry: \_\_\_\_\_

DOCKET NO. 017-0763P

MAY 16 2003

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PLAINTIFF'S  
EXHIBIT  
B

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: SAITO, Kazuo et al. Conf.: 2711  
Appl. No.: 09/899,107 Group: 1745  
Filed: July 6, 2001 Examiner: Alejandro, R.  
For: FUEL CELL SEPARATOR, PROCESS FOR  
PRODUCTION THEREOF, AND POLYMER  
ELECTROLYTE FUEL CELL

LARGE ENTITY TRANSMITTAL FORM

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 25, 2003

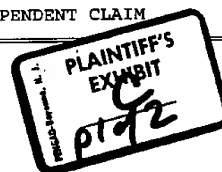
Sir:

Transmitted herewith is an amendment in the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☒ The enclosed document is being transmitted via facsimile.

The fee has been calculated as shown below:

	CLAIMS REMAINING AFTER AMENDMENT			HIGHEST NUMBER PREVIOUSLY PAID FOR			PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL	9	-	20	=	0			\$ 18	\$0.00
INDEPENDENT	3	-	3	=	0			\$ 84	\$0.00
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM								\$280	\$0.00
								TOTAL	\$0.00



- ☐ Petition for ( ) month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$0.00 for the extension of time.
- ☒ No fee is required.
- ☐ Check(s) in the amount of \$0.00 is(are) enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. This form is submitted in triplicate.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

COPY

By \_\_\_\_\_  
Gerald M. Murphy, Jr., #28,977

*encl*  
GMM/DRM:bmp  
0171-0763P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachment(s)

(Rev. 04/30/03)

Certificate of Transmission  
I hereby Certify that this correspondence is being  
transmitted to the Patent and  
Trademark Office:  
Date June 26, 2003  
Signature Gerald M. Murphy, Jr.  
Printed name of person signing certificate Gerald M. Murphy, Jr.



**Birch, Stewart, Kolasch & Birch, LLP**

# Fax

This transmission is intended for the sole use of the individual and entity to whom it is addressed, and may contain information that is privileged, confidential, and exempt from disclosure under applicable law. You are hereby notified that any dissemination, distribution, or duplication of this transmission by someone other than the intended addressee or its designated agent is strictly prohibited. If your receipt of this transmission is in error, please notify this firm immediately by collect call to (703) 205-8000, and send the original transmission to us by return mail at the address above.

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EXHIBIT**  
D



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X                                     TRANSACTION REPORT                          X
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P.O. Box 747  
 Falls Church, Virginia 22040-0747  
 Phone: (703) 205-8000  
 Fax: (703) 205-8050  
 (703) 698-8590 (GIV)

**Birch, Stewart, Kolasch & Birch, LLP**

# Fax

**To:** Examiner Raymond Alejandro      **From:** David R. Murphy *DM*  
**Fax:** 703/872-9311      **Date:** June 26, 2003  
**Phone:**      **Pages:** 38 (including cover sheet)  
**Your Ref.:** 09/899,107      **Our Ref.:** 0171-0763P  
**Re:** Certified English Translated Priority      **CC:**  
 Document

☐ Urgent   
 ☐ For Review   
 ☐ Please Comment   
 ☐ Please Reply   
 ☐ Please Recycle



TO:Auto-reply fax to 7032058050 COMPANY:

## Auto-Reply Facsimile Transmission



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE  
\*\*\*

TO:

Fax Sender at 7032058050

Fax Information

Date Received:

6/26/03 8:16:51 AM [Eastern Daylight Time]

Total Pages:

37 (including cover page)

**ADVISORY:** This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received  
Cover  
Page  
=====>

JUN-26-2003 THU 08:18 AM EST		FAX NO. 7032058050		P. 01
P.O. Box 147 Falls Church, Virginia 22046-0147 Phone: (703) 552-8000 Fax: (703) 552-8050 (FAX)		<b>Birch, Stewart, Kolasch &amp; Birch, LLP</b>		
<b>Fax</b>				
To:	Examiner Raymond Alejandro	From:	David R. Murphy	
Fax:	7038734311	Date:	June 26, 2003	
Phone:		Pages:	37 (including cover sheet)	
Your Ref.:	06709,107	Our Ref.:	0171-0763P	
Re:	Cardinal English Translated Priority	ICD		
Document				
<input type="checkbox"/> Urgent <input type="checkbox"/> New Review <input type="checkbox"/> Please Comment <input type="checkbox"/> Please Reply <input type="checkbox"/> Please Reexamine				
<small>         This transmission is intended for the sole use of the individual and entity to whom it is addressed, and may contain information that is privileged, confidential, and exempt from disclosure under applicable law. You are hereby notified that any dissemination, distribution, or application of this transmission to anyone other than the intended addressee or its designated agent is strictly prohibited. If you are not the intended addressee, please notify the fax immediately by return mail to (703) 552-8000, and delete the original transmission from your system.       </small>				
Comments:				

